

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1897.

McCORMICK HARVESTING MACHINE COMPANY,	}	No. 130.
<i>Appellant,</i>		
<i>vs.</i>		
C. AULTMAN & COMPANY ET AL.,	}	
<i>Appellees.</i>		

McCORMICK HARVESTING MACHINE COMPANY,	}	No. 131.
<i>Appellant,</i>		
<i>vs.</i>		
AULTMAN-MILLER COMPANY,	}	
<i>Appellee.</i>		

ON A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

BRIEF FOR McCORMICK HARVESTING MACHINE COMPANY, APPELLANT.

STATEMENT.

The question certified, to which the issue here is confined, is stated on the first and second pages of the transcript. It does not relate to the effect which proceedings in the Patent Office might have on a grant derived through those proceedings, or the effect which the acceptance of a limited grant may have in concluding the party against asserting a broader title, but presents the question whether an inchoate attempt of the executrix of the patentee to amend the patent by reissue, which never passed into any public records, from which no grant was ever derived, under which no title was obtained or asserted, which was withdrawn with the avowed purpose of relying on and as-

serting the original patent instead of prosecuting the application for reissue, must operate as a cancellation of the claims which the owner of the patent thus refused to surrender and which the Patent Office itself never undertook to cancel.

The patent in suit is the *original* Gorham patent for "Grain Binder," dated February 9, 1875, a patent which, as found by the Circuit Court of Appeals, introduced the first automatic twine-binder that ever successfully bound grain in the field, and upon the substantial plan of which have been built practically all the grain-binders which have gone upon the market or into public use. (*Rec.*, pp. 2-16.) These defendants, who have built without license machines corresponding in all material respects to those which the other manufacturers were building under the patent, indicated their recognition of its value by entering into a contract with the executrix of the patentee from whom complainant had acquired title, by which they and their associates offered \$100,000 and all expenses of litigation if she would set aside complainant's title and assign to them. (*Rec.*, p. 16.) Failing in this, they are insisting that the claims of the original patent, which the court finds to embrace a novel and extremely valuable invention, and to be infringed by defendants, were forfeited by a secret application for reissue made by Gorham's widow (acting as executrix) before complainant acquired control of the patent, and withdrawn before the form in which the reissue application should be presented for the final action of the Commissioner had been settled.

The Circuit Court of Appeals having found this invention to be one of extraordinary merit and originality, which solved a problem that had baffled inventors for many years and substituted the automatic twine-binder for hand-binding, has submitted to this court the question whether the original patent was invalidated by an application for reissue made by the executrix after the death of the patentee, and withdrawn before any final action had been taken upon it, the complainant, who had meanwhile acquired title to the original patent, having prevented further prosecution of the application for reissue by demanding and obtaining from the Patent Office the

restoration of the original patent without cancellation or modification of any kind.

The widow of the patentee, being also his executrix, filed in the spring of 1881 an application for a reissue of this patent, containing, in addition to the claims in the original, various new ones. This was before *Miller v. Brass Co.*, 104 U. S., 350, overruled the doctrine of *Marsh v. Seymour*, 97 U. S., 348; *Corn Planter Cases*, 23 Wall., 181; *Seymour v. Marsh*, 11 Wall., 316, and other cases reaching back to *Grant v. Raymond*, 6 Pet., 218, which were generally understood to have authoritatively construed the law as conferring the right to reissue at any time during the life of the patent for the purpose of inserting claims covering

“not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings or Patent Office models, which properly belonged to the invention as actually made and perfected.” (97 U. S., 348.)

It was then a common expedient to reissue a patent for the sole purpose of inserting additional claims and giving it a more imposing appearance, without much reference to whether the original patent was legally adequate to protect the invention. Adding to the number of claims in this way was popularly supposed to add to the commercial value of the patent. If this widow had gone with the most adequately drawn patent that ever issued to the average patent solicitor of those times (who, for the most part, were not lawyers, and found a profitable occupation in applying for reissues) and stated that she wished to sell such patent, the first suggestion would generally have been to reissue it with additional claims. Such additional claims were often inserted, not because the original claims were insufficient to protect the invention under recognized rules of judicial construction, but because of a desire to express them in language more impressive to the trade and to persons unfamiliar with these rules of construction, or because the solicitor advised claiming features shown in the patent but not included in the claims.

Such applications go, in the first instance, to one of the sub-

ordinate examiners or clerks in the Patent Office, who is charged with making, for the instruction both of the Commissioner and of the applicant, the examination provided for in Section 4893 of the Revised Statutes. It is his duty to inform the applicant by letter of any prior patent which, in his opinion, may require modifications of either the specification or claims (which he usually does by saying that certain claims are "rejected" on the references specified), leaving the applicant to examine the references thus cited and determine whether, in view of them, he prefers to insist upon the allowance of these claims in their original form or to modify them so as to express more clearly the distinctions between his invention and the references cited, or to erase them altogether and accept the patent with these claims omitted. Such "rejections" conclude nothing. The applicant may by letter or by oral argument satisfy the examiner that he has mistaken either the prior devices or the essential character of the present invention, and obtain his approval of the claims thus rejected, or he may modify the claims so as to embrace the invention quite as broadly but in language more satisfactory to the fancy of the examiner, or to express in the claims themselves the distinctions which he regards as already sufficiently implied by the specification but which the examiner has overlooked; or, if satisfied that the references are entirely irrelevant, he may refuse to make any changes or to further discuss the matter with the examiner, and insist upon the allowance by the Commissioner of the application as drawn, including all the claims objected to by the examiner. The examiner has no power to adjudicate the rights of the applicant either affirmatively or negatively. He can refuse to approve the application until formulated in terms that conform to his fancy, and if the applicant refuses to alter the application and insists upon its allowance without alteration, he may report to his superiors the grounds of his objections or "rejections," and leave them to determine whether they are well taken. He is not the *Patent Office*, but a clerk in that office. He is not even one of the "Examiners-in-Chief" provided for in section 476 of the Revised Statutes, but one of the clerks au-

thorized by section 169. The fact that he assumes an air of authority in his correspondence does not change its advisory and confidential character. He has no power to either issue or withhold a patent, though if the applicant, either by accepting his suggestions or by persuading him that his objections are not well founded, obtains his approval of the application in the form in which it is then expressed, the proper officials would ordinarily issue the patent as the result of such approval, unless they saw some special reason for ordering otherwise. Nothing is consummated until the patent is issued. This correspondence is confidential and not matter of public record. It is a means of settling as far as possible, by exchange of views between the examiner and applicant, the form in which the application will finally be insisted upon for the action of the Commissioner, or of making up the issues to be passed upon by the Commissioner. It often happens that the examiner is a novice, either in respect to the class of machinery with which he is dealing or in respect to the rules of legal construction, and, misled by some superficial resemblance, cites references which are altogether foreign to the invention and withdraws his objections when the differences are explained by the applicant or his solicitor. Sometimes his principal concern is to get temporarily rid of the application while appearing to keep up with his work, and he does so before making any careful examination of specification or claims, by "rejecting" on any prior patents that show a visual resemblance to some of the elements claimed, thus transferring to the applicant or his solicitor the burden of pointing out and explaining to him thereafter the essential distinctions between the references and the pending claims.

These rejections are only preliminary to a further consideration of the case, and are often followed by an allowance of the rejected claims by the same examiner.

Mrs. Gorham's application for a reissue met this usual treatment at the time it was filed, and had not passed beyond this preliminary stage when the original patent (which, under the law then and ever since in force, was not surrendered until the reissue was granted) was purchased by the complainant and

others whose title complainant afterwards acquired. They insisted on their right to the original patent, stopped the attempt to reissue, and obtained from the Patent Office the return of the original patent (which was filed with the application under a provision of the statute by which it required that it be cancelled *when the reissue was granted*), and promptly brought suit upon it.

The reissue application was therefore withdrawn before any final action had been taken upon it by the Patent Office, or any surrender of the original had taken effect, and the title upon which complainant now stands rests upon the original grant (not upon a grant derived through this reissue application), whose validity and construction is committed solely to the judgment of the courts rather than to the Patent Office. The complainant, acting on the assumption that the patent did not require amendment, and unwilling to incur the delay and other disadvantages incident to prosecuting or accepting a reissue, asserted its right to rely upon the original patent, which was immediately available to it, and to thus carry the controversy directly into a court which had jurisdiction (as the Patent Office had not) to finally determine the validity and scope of that patent and administer relief thereunder.

These cases were heard in the Circuit Court before his Honor Judge Jackson, then circuit judge. He held that by withdrawing the application for reissue and bringing the suit on the original patent the complainant had acquiesced in the objections which the examiner had made in his correspondence to claims of the reissue application; that this operated as a cancellation of all similar claims in the original, and that the files of this reissue proceeding (which never passed to a grant) superseded the title which the complainant held under the original patent and controlled the construction and validity of that patent. He cited as supporting this action such cases as *Robinson v. Sutter*, 119 U. S., 54, and *Shepard v. Carrigan*, 16 U. S., 595, apparently not distinguishing between the effect which proceedings in the Patent Office might have in explaining the meaning of ambiguous language in a grant growing out of such proceedings, or the effect which the ac-

ceptance of certain restrictions might have upon a grant which issued in consideration of such restrictions, and the case of a patent which did not grow out of such Patent Office proceedings, which had not been changed in terms in consequence of such proceedings and the issue and acceptance of which long antedated such proceedings. He seems to have confounded the withdrawal of the application for reissue before there had been any final action upon it, and the immediate assertion of right under the original patent, with cases where amendments introduced in response to objections from an examiner, and thereby made a part of the grant under which title is asserted, have been referred to as explanatory of the terms of that grant; to have overlooked the fact that the Patent Office has no power to either cancel or restrict a patent after it has issued, except by granting a reissue to supersede it; and to have failed to distinguish between its power to determine in what terms it will make a new grant through a patent officially signed and sealed, and the insufficiency of a confidential letter of a subordinate in the Office to alter the legal effect of an existing patent which the Patent Office determined to leave unmodified.

The opinion of the Circuit Court treated the assertion of the right before the only tribunal which, under modern decisions, had any jurisdiction to determine the validity of an existing patent as an abandonment of that right. It confused the confidential preliminary correspondence of an examiner, never adopted or acted upon by the Office, with a "judgment" and the election to stand upon a prior existing title instead of submitting to the conditions of procuring the grant of a different title, with the acceptance of a title granted on such conditions. It undertook to create an estoppel against one who had neither misled others nor received advantage, and in favor of those who had been in no respect affected or prejudiced, and to create a condition of forfeiture unknown to the statute and unsupported by any equity. (58 Fed. Rep., 773.)

The Circuit Court of Appeals found, as appears in its statement and opinion, that there was nothing in these proceedings on the part of the applicant "which, regarded merely as evi-

dence or by way of estoppel, should limit or narrow the construction" of the claims in controversy (*p. 1*). It also found from the evidence in the record that the withdrawal of the application for reissue (*p. 27*) "was with no intention of abandoning their alleged right to a wide construction of the claims of the original patent," and said, referring to the application which the court had made below of *Sutter v. Robinson and Shepard v. Carrigan* (*p. 28*):

"It is difficult to see how such a principle can apply in the case of an application for a reissue which is not carried to the point of surrender of the patent and the acceptance of a new patent. Nothing is granted to the patentee which he did not have before and there is, therefore, no privilege or benefit moving from the Government to the patentee upon which an estoppel can be founded."

Having naturally great respect for the opinion of the judge who decided the case below and apparently entertaining some doubt about the significance of an expression of this court in *Peck v. Collins*, 103 U. S., 660, the Circuit Court of Appeals, after finding the patent valid and infringed unless the proceedings in the Patent Office operated as a cancellation of the claims in the original, has certified to this court for its instructions the following question (*p. 2*):

"If the owner of a patent applies to the Patent Office for a reissue of it and includes, among the claims in the application, the same claims as those which were included in the old patent, and the primary examiner rejects some of such claims for want of patentable novelty, by reference to prior patents, and allows others, both old and new, does the owner of the patent, by taking no appeal and by abandoning his application for reissue, hold the original patent (the return of which he procures from the Patent Office) invalidated as to those of its claims which were disallowed for want of patentable novelty by the primary examiner in the proceeding for reissue?"

It is insisted in behalf of complainant below that the original patent remains in force for its full term unless meanwhile superseded by the grant of a reissue or cancelled by a decree of court; that the Patent Office has no power to modify a patent once issued, except through the grant of such a reissue as the owner may accept in lieu of the original; that even if it had

such power it has not exercised it in this case, but has acquiesced in the election of the assignee to withdraw the application for reissue and assert right under the original, by returning the original unmodified; that if in the judgment of the purchaser of the patent or of its counsel the original patent was adequate and a reissue unnecessary the only legitimate and honest course was to withdraw the application for reissue (which the law only authorized where the original patent was defective) and submit directly to the court the question of the validity and construction of the patent already in force; that in taking this course complainant neither relinquished any right which the original grant conferred, nor acquired any benefit from the reissue application, nor inflicted any prejudice upon the public; that such objections as the examiner made to claims submitted to him could not alter the nature of the original patent until they were accepted and given effect by the promulgation of a reissue conformable to them, under the seal of the Patent Office, signed by the Secretary of the Interior and countersigned by the Commissioner, which would thenceforth supersede the original patent as the source of title and definition of right; that until thus acted upon they could not be taken as indicating what judgment the *Patent Office* (or even the examiner himself) would ultimately reach on the propriety of allowing these claims in the terms in which they were expressed, nor did they indicate the opinion of the examiner on the very different question whether such claims, when in a patent, were capable of such a construction as would sustain them and make them effectual; that if, from the standpoint of the Examiner, claims submitted for allowance seemed capable of a construction which would cover prior machines, that might be a reason for refusing to recommend their inclusion in a new franchise which was still subject to revision, and for requiring the applicant, as a condition of obtaining the examiner's approval of the proposed amendments, to so draft these claims as to express in terms satisfactory to the examiner the distinctions on which the patentee relied, when, in passing upon the validity of the same claims in a patent already in force, governed, as

he must be, by the rule, *ut res magis valeat quam pereat*, the same examiner would have no hesitation in sustaining the claims with a construction that abundantly distinguished the invention from the prior art; that the court in passing upon the validity of the original patent could give as much or as little weight to the objections urged against them by the examiner as in its judgment they deserved, and determine (as it has done in the present case) whether the claims were entitled to a construction that distinguished them from the prior patents on which the examiner had based his objections, and, if satisfied that they were, when read in connection with the specification, entitled to a construction that made them valid notwithstanding these references, it was its duty to so adjudicate; that its judgment, however it might be influenced by, was not subordinated to, his opinions thus tentatively indicated; that the obligation to determine the validity and interpretation of the original patent rested upon the court and could not be shifted to an examiner who had no part in framing that patent; that there is nothing in the terms of the statute to require such a forfeiture as is here contended for by defendants below, and no legal or equitable consideration to justify it; that the *sempre* in *Peck v. Collins*, invoked by the Circuit Court, refers to the effect of an *adjudication* by a decree of court upon an issue which that court had jurisdiction to determine, and has no application to such advisory correspondence of an examiner as never resulted in a decree or grant of any kind; that the decisions upon the effect of Patent Office correspondence on the interpretation of claims resulting from such correspondence give no support to the proposition that correspondence subsequent to the patent in suit can supersede, abrogate or nullify the claims with which that patent issued, or to the proposition that such correspondence can operate to expunge claims from patents which receive no modification in consequence of it and are not derived through it; that the jurisdiction of the Office was confined to determining whether it would issue a new grant to replace the original, and in what terms that new grant should be expressed, while the question whether the old grant was valid or invalid was, until it was

superseded by the grant of a reissue, a question solely for the courts; that if it were to be imagined that the Patent Office had any control of the original, that control was voluntarily surrendered by it when it returned the patent uncanceled and unmodified; and that this return of the patent, including all the original claims, being subsequent to the letters of the examiner, would supersede them in effect, so far as they can be supposed to have any effect, and must be considered either as the decision of the Office to permit the applicant to retain and assert the original patent without modification or qualification, or as a recognition of the right to withdraw the application without prejudice and assert the original franchise in the courts having jurisdiction to construe and adjudicate it.

THE ORIGINAL PATENT WAS NEVER SUPERSEDED OR MODIFIED.

A patent issued *under the seal of the Patent Office*, duly signed and countersigned, is the instrument provided by statute for defining the franchise with which the patentee is vested. It is a public document, uttered in the name of the United States, authenticated by the officials who alone have power to consummate such a grant. Thenceforth it defines the right which the grantee is entitled to assert throughout its term, and the jurisdiction to determine its validity and scope is committed exclusively to the federal courts. The Patent Office cannot, during its term, abridge this franchise except by issuing an "amended patent" (commonly called a "reissue") to supersede it. This it is authorized to do only on certain specified conditions. It has the same power to revise an application for reissue as it has to revise an application for an original patent, and these revisions, *when consummated* by the issue of the amended patent containing them, have the same effect on that amended patent as similar revisions in an original application have upon the original patent, controlling to the same extent all claims asserted under the amended patent in which they are incorporated. But the power of revision relates to the patent which is issued on the pending application, and is only exercised in framing and issuing that patent. It only becomes

operative when consummated by the issue of that patent with such revisions included therein. Until such issue, there is no *determination* concerning the extent or character of the amended patent; no *adjudication* of rights; no *acquisition* of right; no *acceptance* of conditions or restrictions; no *consummation* of any kind. A letter of an examiner addressed to an applicant urging objections to certain claims is only advisory and preliminary to further proceedings. It concludes nothing as to the terms or scope with which that pending application may be finally allowed, and is in no sense a "*judgment*" or "*adjudication*" of any issue. The judgment of the Patent Office is expressed by the public grant of a patent under its official seal, not by the confidential correspondence of a subordinate examiner out of which no grant ever sprung. Such correspondence is neither published nor open to public inspection. The fact that such an application was made is treated as confidential, the public having no notice or intimation of it until the patent issues upon it. Copies of such withdrawn applications can only be obtained by those connected with its prosecution or by a special order of the Commissioner in person upon a petition showing the applicant to be informed of its existence and to have some special equity entitling him to a copy. (*United States, ex rel. Bulkley v. Butterworth, Com.*, 81 Off. Gaz., 505; *United States, ex rel. Fowler*, 62 Off. Gaz., 1968.)

If it had been intended that such letters of subordinates in the Office were to supersede and cancel the claims of patents issued under the great seal of the Patent Office, signed by the Secretary of the Interior and countersigned by the Commissioner, some provision would have been made for giving them public official expression.

The first section of the statute relating to patents (Revised Statutes, 4883) provides that—

“ All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the

Patent Office, in books to be kept for that purpose."

Certainly it was not intended that a grant thus formally authenticated, promulgated and recorded should be subjected to modification by the unpublished, confidential letters of any clerk or examiner in the Patent Office to whom was committed the task of in the first instance making the investigation preliminary to the issue of another franchise.

The same enactment provided in terms for the cancellation or modification of a patent in two ways: *first*, by a decree of court under certain specified conditions, and, *second*, under certain other specified conditions, by the issue of an "amended" patent which should from the time of issue supersede the original patent as the *grant* through which the patentee derived title. No provision was made by which an *examiner* could either diminish or enlarge the grant after it had once issued. If it had been intended that he should exercise that power some provision would have been made for the publication and authentication of his act. The examiner or clerk is not *the Patent Office*. Not even the Commissioner can individually restrict or recall or modify a grant which has once issued in the manner prescribed by law. A letter from the Commissioner, though signed by him as Commissioner, would be inoperative to cancel or modify such a grant. Such a letter can no more recall or cancel a government grant than confer such grant. Any utterance by the Commissioner, other than the actual grant of a patent, though in the form of an official certificate of correction intended to modify a patent already granted, is inoperative and without legal effect. (*Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 52 Fed. Rep., 300, C. C. A., Second Circuit.) The examiner may, by preliminary investigation and correspondence, help to inform both the Commissioner and the applicant about the propriety of issuing a patent and the kind of claims proper to be allowed. If the applicant accepts the advice of the examiner and voluntarily modifies his application to conform with the views of the examiner, the Commissioner may, if he chooses (though he is not controlled thereby), cause it to pass to issue in that form, and, when issued with the

formalities required by law to give it force, it becomes conclusive on the applicant so far as any rights asserted thereunder are concerned. But the work of the examiner is only advisory, and has no legal effect in either conferring or restricting a franchise except as it may be adopted and acted upon in the formal grant, duly signed and sealed, by which the Patent Office registers its official acts.

In *ex parte Starr*, 15 Off. Gaz., 1053, decided by Commissioner Payne shortly before the application for the reissue here under consideration, the fact that a rejection by an examiner was only preliminary to a consideration of the issue by the examiner, that it concluded neither the examiner nor the Patent Office nor the applicant, and that no action short of the official allowance of the patent could be regarded as settling the action of the examiner, was very distinctly pointed out, while in *ex parte Neale*, 15 Off. Gaz., 511, the same Commissioner held that the Patent Office was not concluded either by the action of the examiner in finally allowing the patent, or by the completion of other formalities, including the affixing of the Commissioner's signature, if the patent had not been both signed and sealed, as required by law. In the first mentioned of these cases the Commissioner says (p. 1054):

"The rules require an Examiner to notify the applicant of a rejection without delay; but if such notice is not followed by an amendment, the Examiner is not precluded by this action from a reconsideration. On the contrary, he is authorized and required, at the request of the applicant, to reconsider, and, upon such reconsideration, may either affirm or reverse his first decision. I find no provision in the law or rules for the communication to the applicant of a favorable decision on the merits, either as to the whole case or as to particular objections met or abandoned, except the provision for an official notice of allowance. I think there ought not to be any other provision in the law or rules. I doubt the wisdom of such a provision.

"... But it seems to me that, up the time when this official notice of allowance is given, the judgment and conscience of the Examiner ought, so far as the merits of the case are concerned, to be as unfettered as is that of the court up to the moment when a judgment is signed, whatever questions, answers, suggestions, or intimations

of opinion may or may not have been made on the trial or during the pendency of the case.

“While an Examiner is obliged to reconsider, at the applicant’s request, after one rejection, he is not obliged to reconsider after a second rejection of the same claim. A motion by an applicant for such a reconsideration would ordinarily be overruled. But if the Examiner himself should, upon further scrutiny or reflection, encounter considerations satisfying him that he had made a mistake, he would be at liberty to reconsider his rejection and pass the patent to issue. It appears, therefore, that in all cases a reconsideration of the merits by an Examiner, on his own motion, is permissible until the official notice of allowance is given.”

That the Commissioner is charged with the final duty of determining whether a patent shall issue and that nothing is concluded until the patent is both signed and sealed is also very clearly stated in the decision of the Secretary of the Interior *in re Hunt*, 13 O. G., 771, and in *Hall v. Commissioner of Patents*, 2 McArthur, 90. See, also, *Butterworth v. Hoe*, 112 U. S., 50, particularly pp. 52, 59, 64, 66.

The examiner could not cancel any claim in the application pending before him. He could only refuse to recommend its allowance, leaving the applicant, if unable to overcome his objections by argument, either to express the claims in terms more satisfactory to the examiner (and which might be quite as comprehensive in legal effect), or to insist upon the same claims before the examiners-in-chief or the Commissioner in person; or, if, as in the present case, he preferred to take the judgment of the court on the grant already in existence rather than spend time in seeking a new grant, he could withdraw his request for an amendment of the patent and assert his right under the patent in the original form, in the court having jurisdiction to construe and enforce it. If, before the surrender had taken effect, the executrix who filed the application concluded, under advice of new counsel, that the original patent required no amendment, or if the purchasers of the patent (which the public records showed to be still in force) were unwilling to surrender it, or were advised that there was no occasion for reissue, it would have been folly,

if not worse, for them to prosecute the application for reissue, when the Office would immediately restore them the original uncanceled. If the original specification and claims were, in their opinion, adequate, the conditions under which the law authorized the grant of a reissue did not exist. Any reissue granted pursuant to the application might be held invalid as not authorized by statute. No opinion that the Patent Office might be induced to express concerning the validity of the claims of the original patent, or the right to additional claims, could control the court in which relief must ultimately be sought. The most direct method of taking the opinion of such court was that which the complainant took with the acquiescence of the Patent Office. It is immaterial whether it took this course because advised by its counsel that the original patent was, under the usual rules of legal construction, adequate to secure the essential features of the invention, or because its counsel doubted the jurisdiction of the Patent Office to grant any reissue so long after the date of the original, where the specification was not fatally defective, or because it understood better than the executrix the relative value of an original patent which was immediately available for the purpose of prosecuting infringers. If advised that the patent did not come within the conditions under which a reissue was authorized; that the jurisdiction of the Patent Office to entertain such an application was doubtful; that, so far as the reissue intended to secure new claims, it was, under decisions subsequent to filing the application, barred by lapse of time between the grant of the original and the application for reissue; and that, so far as it related only to the original claims, no amendment of the original patent was necessary, and the proper remedy was by suit in court rather than by prosecuting an application before the Patent Office, they could not properly or consistently do otherwise than stand upon the existing title, withdraw the application for its amendment, and submit the original patent to the judgment of the proper court.

If a party desires to change the terms of a contract already in existence, and submits it to the opposing party for amendments, and the amendments are incorporated therein and a new

contract containing them executed and delivered in lieu of the original, that new contract must thereafter control the rights of the parties. But if the opposing party insists upon cancelling some of the provisions of the old contract as a condition of executing the new, and, the other party declining to accede to these conditions, no new contract is ever executed but the old one is returned in its original form at the request of the party first proposing these amendments, it certainly could not be reasonably contended that it must be henceforth treated as subject to all the modifications insisted upon as a condition of amending it. Yet such contention would be quite as reasonable as that here urged in behalf of the defense.

If the action of the examiner is to be treated as carving out of the original patent such claims as he had not approved for the purpose of the reissue, when did the original patent become thus mutilated? Was it when the examiner wrote these letters? Was the original patent changing character with every successive private letter of the examiner, when it could not yet appear but what either he or those controlling his action would allow every claim asked for? Did it take effect when the patent was returned? For all that appears, the Patent Office may then have been satisfied that the applicant was entitled to all the claims of the original. The return of the patent, uncanceled and unmodified, certainly indicates that it had reached no conclusion which warranted it in modifying that patent, and that it conceded the right of the patentee to continue to assert that patent precisely as if no effort to reissue it had ever been made. It would be a strange inversion of logic to treat this return of the patent in its original form as an official cancellation of it or any part of it. It was the plainest possible recognition of the right of the applicant to withdraw without prejudice and seek his remedy under the original grant in the proper tribunal.

The statute has provided that any assignment of a patent or of an exclusive right thereunder must be recorded in a public record kept for the purpose, in order to affect subsequent purchasers without notice. Can it be that any purchaser of a patent which is still in force is liable to find that its principal

claims have been cancelled by the confidential correspondence of an examiner over a reissue application, when the public records contain no hint that any reissue application was ever filed, and no suggestion that the patent has ever been modified?

THERE WAS NO ABANDONMENT OR CANCELLATION OF THE ORIGINAL PATENT OR ANY PART OF IT.

If the Patent Office had the power to cancel any portion of the original patent in any other way than by reissuing it (and it would seem clear that it had not), it is certain that it never exercised that power in this case. On the contrary, the only determination which it reached was to permit the original patent to remain unchanged and restore it to the parties in interest without addition or subtraction. It acquiesced in their withdrawal of the application for amendment and their election to stand upon the original grant, before any amendment had been made or any agreement or settlement reached with reference to what amendment would be allowed. It treated the examiner's correspondence as affording no sufficient reason for destroying the existing franchise or cancelling any part of it. It gave no official effect to that correspondence, but, so far as it decided anything, decided to leave the original patent in force, precisely as if no application for reissue had been filed. It terminated the proceedings by returning this original patent, to remain its only official expression concerning the franchise, the public authentication and definition of the patentee's right, without making any entry upon it or upon the public records of the Office to indicate that it saw occasion to alter or restrict it. That original had been filed with the application, partly to show that the executrix had custody of the original grant at the time of applying for this amendment, and partly to enable the Patent Office to cancel it when a reissue should be granted to supersede it—the only time at which, under the statute, it had any power to cancel or alter it. The application had never reached the stage when the statute authorized its cancellation or when a surrender of it could take effect.

If the Patent Office acquired, by the pendency of this application for amendment, any such control of the original patent as would enable it to refuse to restore it, if requested before a reissue had been consummated, its action in returning the patent in its original form must be regarded as the nearest approach to a "judgment" or "adjudication" reached by it, and as expressing its conclusion to permit the claims of the original patent to remain in operation as its official declaration of the rights secured to the patentee. If the Patent Office had no such control over the original as to give it discretion to refuse the return of the patent without revision whenever requested by the parties in interest prior to the grant of a reissue, it certainly had no power to change its legal effect or to withhold any part of the franchise conferred by it. It made no attempt to exercise such power.

The right to withdraw an application for reissue, and the fact that by such withdrawal the original is left in force, has been expressly recognized by this court. (*Allen v. Culp*, 166 U. S., 501).

The request for the return of the original patent was made before it appeared whether the Patent Office would or would not officially adopt the views of the examiner either in respect to allowing the new claims which he had approved or in objecting to such of the old claims as had not thus far been approved by him, and before it appeared whether the examiner himself would finally insist upon his objections or admit that they were not well taken. It was made before the applicant had cancelled the claims in dispute or accepted any modification of them, and before any expression of the examiner had become binding either upon the Office or upon the applicant. How could this direct assertion of right to the unmodified original patent on the part of the assignee, and this assent to that assertion of right on the part of the Patent Office, operate to destroy the right thus asserted and recognized, or any part of that right? How could the decision to stand upon the original patent be interpreted as an abandonment of the rights purporting to be secured by that patent? Why should this be distorted into anything but the withdrawal of the request for

amendment of the existing franchise, the election to rely upon the original grant without addition or subtraction, and the concurrence of the Patent Office in relegating all questions affecting the validity of that patent to the courts having jurisdiction to administer an existing franchise?

The Court of Appeals has found (*Rec.*, p. 27, at the bottom of p. 1) upon the evidence before it that the withdrawal of the application for reissue was "with no intention of abandoning the alleged right to a wide construction of the claims of the original patent," and that there is nothing in the files "which merely as evidence upon the construction of the original patent or its claims would either limit or narrow them." It is not pretended that anybody has been misled or in any way prejudiced by this application for amendment lodged by this executrix in the secret archives of the Patent Office and withdrawn for the express purpose of asserting the original patent before any amendment had been granted and before any knowledge of the application or proceedings thereon had become public; nor is it pretended that the defendants, or the public, had any knowledge of the reissue application until long after they had by these suits been made definitely aware of the fact that complainant was still asserting, and relying upon, the original grant. They could then only ascertain that such application had been made through the betrayal of confidence by some person who had been privy to it, and, whenever through such privy access was obtained to this correspondence, it showed unmistakably that the parties had elected to assert the original grant instead of amending it, and that the Office had sanctioned that election by returning it to them unmodified. The application had affected no one, except as it had burdened the estate of the patentee with the expense incident to it. The government is paid in advance the full charge for examining reissue applications, and the fees exacted are so much in excess of the cost to the department that a large surplus is carried over to the treasury every year.

The distinction between an abandonment of an *application* and an abandonment of the *invention embraced in that application* has been repeatedly recognized by the courts.

In *Lindsay v. Stein*, 20 Blatch., 370, a case decided shortly before this reissue application was withdrawn, there had been an application for a patent which was twice rejected on reference to prior patents which the examiner insisted anticipated the invention. After the second rejection it was abandoned and allowed to become forfeited under the statute. A new application was made for the same invention more than three years after this last rejection, and after this abandonment had been concluded by the statute. The court (Blatchford, J.) held that the abandonment of the application after rejection did not operate as an abandonment of the invention, and sustained the patent allowed on the subsequent application, saying (p. 376):

“The defendant contends that the effect of the Act of 1870 is, that when an application is, under § 32, to be regarded as abandoned, no new application for a patent for the same thing can be subsequently made. There is nothing to prevent a subsequent application. When made, it can derive no aid, as to time, from the prior abandoned application, and the applicant must stand, as to defenses in suits on the patent, as if the new application were the first application.”

The patent there under consideration was granted in 1878 and governed by the law in force at the time the patent here in suit was granted and the application for reissue made and withdrawn.

If the *abandonment* of an application after rejection does not affect the right to make a *similar* application thereafter, there would seem to be much stronger reasons why the withdrawal of an application for *amendment*, with the avowed purpose of asserting the *original franchise* (which is simultaneously withdrawn from the control of the Office), should not affect any rights secured thereunder.

Abandonment or forfeiture of a right is never to be inferred where the circumstances are fairly capable of any other interpretation. Certainly it is not to be inferred from conduct which expresses unmistakably the intention to assert that right—which is in fact the most positive assertion of it as a continuing right.

**WITHDRAWAL OF APPLICATION FOR AMENDMENT NOT TO BE CONFUSED
WITH ACCEPTANCE OF EXAMINER'S SUGGESTIONS.**

Instead of accepting the views of the examiner as indicated by his correspondence, and modifying the application to correspond therewith, the owners of the patent refused to modify their application in conformity therewith, declined to surrender the original patent, and resumed custody of it.

The Circuit Court appeared to confuse this case with those where rejections and amendments in the proceedings through which a patent acquired the form in which it issued have been treated as explanatory of the *grant thus formulated*, or where a cancellation or qualification of claims objected to by the examiner, and the acceptance of a grant bearing upon its face the restrictions thus imposed, has been held to estop the patentee and those claiming under him from asserting, *under a patent thus obtained*, rights which were excluded from it as a condition of its allowance.

Manifestly none of the reasons for treating the correspondence which resulted in the grant of a patent as *explanatory of the terms* of that grant, or for treating the *adoption* of restrictions in the claims of a patent as controlling upon a *grant thus obtained*, are applicable here.

The patent in suit was not derived through the correspondence here invoked, but existed in its present form long before that correspondence occurred. No modification in its terms was made in consequence of such correspondence. Its language is the same as when it first issued and cannot mean either more or less than it did then. The examiner who conducted the correspondence had nothing to do with framing the patent in suit. It does not appear that he was connected with the Patent Office at the time it issued. The parties to the re-issue application, instead of acquiescing in the views of the examiner and amending the application accordingly, refused to abandon the original claims or to accept anything less than the original franchise, and the Patent Office, instead of annulling the patent, left it in force. There could be no more emphatic refusal to accept the opinions of the examiner and no more

direct method of insisting upon the original claims than that taken in this case. It said plainly that instead of further discussing with the Patent Office the propriety of granting such a reissue as the executrix had asked for, the present owners of the patent would leave the franchise in its original form and take the opinion of the courts on the validity and sufficiency of the claims which it already contained.

The decisions which have referred to the proceedings in the Patent Office preliminary to the grant of a patent as explanatory of the significance of terms used in that patent have proceeded upon the theory that the meaning of such terms might sometimes be explained by the circumstances under which they were introduced. Even in this aspect, such evidence has to be considered with great caution. The correspondence cannot *overrule* the terms in which the grant is finally expressed, for the official grant must be taken as the last and decisive expression of the Patent Office. The rule which prevents a contract from being modified by preliminary correspondence applies with special force in cases where (as in the prosecution of an application for a patent) part of the proceedings are expressed in writing, and part, which sometimes determines the language in which the instrument is issued, may be oral and not appear in the records. It has been held that such files could do no more than explain the significance of the terms of the patent when consistent with such terms. They cannot contradict or overrule or supersede the terms in which the instrument is issued. To admit that any portion of the specification or claims of a patent could be *nullified* by expressions of opinion on the part of subordinates in the Office during the preliminary examination and correspondence would be to set at defiance the well-established rules controlling the construction of instruments and grants. The proposition of the defense here goes much further than this, and seeks to make such correspondence nullify the terms of an existing grant of government which was not formulated by the examiner expressing these opinions, or derived through any proceedings of which they were a part.

**THE PATENT OFFICE NEITHER ADJUDICATED NOR EXPRESSED OPINION
UPON THE VALIDITY OF ANY CLAIM IN THE ORIGINAL PATENT OTH-
ERWISE THAN BY RETURNING THAT PATENT UNMODIFIED.**

The correspondence between an examiner and an applicant is for the purpose of enabling an applicant to determine whether he will insist upon his application in the form originally submitted or put it in such form as meets the approval of the particular examiner to whom it is in the first instance referred. The examiner has no power to alter the specification or claims in any respect, but if they seem to him capable of a construction that would cover prior devices, or objectionable in any other way, he may object to them, informing the applicant of the nature of the objections and giving him an opportunity either to satisfy the examiner that the objections are based on misapprehension, or to accept the views of the examiner and modify the application in accordance therewith, or to refuse to defer to the judgment of the examiner and prosecute the application in the original form, in which latter case the Commissioner may either accept the views of the examiner or reject them, according as he thinks them well taken or otherwise. This correspondence of the examiner is only preliminary and advisory. His expressions are in no sense "judgments" or "adjudications." The judgment of the *Patent Office* is not expressed and does not become operative except through the formal grant, properly sealed, signed and countersigned. It does not become an expression of the opinion of the Office upon the matters under discussion except as consummated by a grant adopting officially the conclusions of the subordinate. It does not even indicate the opinion of the subordinate examiner upon the legal effect of the claims of the original patent, for the question whether certain claims were such as he would approve for allowance when entrusted with advising the Commissioner as to the terms in which he would recommend the issue of a new grant was very different from the question whether such claims in a patent already in existence were capable of such a construction as would sufficiently distinguish the invention from the prior art, and hence of being sustained so as to

effectuate the purpose of the grant. The question which arises where an instrument is to be revised is essentially different from that which arises where the validity of that instrument is to be adjudicated. An examiner in considering whether he will approve an application for allowance may object to claims which do not recite the distinctions between the invention and the prior art in as apt language as he thinks desirable, when a court having to pass upon the validity of claims in a grant already in force may hold that such claims, when read in connection with the specification, sufficiently distinguish the invention from the prior art, and are entitled to be sustained, though it may think them so inartificially drawn that it would have revised them if charged with that duty. An examiner who has certain fancies in determining the language in which he will advise the issue of a patent, often objects to a claim merely because, when read apart from the specification and without reference to the invention exhibited in that specification, its terms may seem to him to be satisfied by some prior device entirely foreign to the invention disclosed in the specification, when, if the same examiner had submitted to him the question whether these claims in an existing patent were entitled to such a construction as would distinguish the invention of the patent from that of the prior art, he would not have the slightest hesitation in answering that question in the affirmative. A lawyer who is charged with revising an instrument before it is executed may strike out phrases and insert others to reconcile the instrument to what he considers the best form of expression, or to embody in express terms distinctions which might otherwise be left to implication, when, if the same instrument was submitted to him after being executed in its original form, he would unhesitatingly pronounce it valid. The form of expression and the extent to which the claim shall recite the necessary association of the elements referred to, or leave them to be determined under the words "substantially as and for the purposes specified," by referring back to the title, statement of invention and description which precede, is a subject upon which the practice of the subordinates in the Patent Of-

fice differs as much as the same number of lawyers might differ in the expressions which they would recommend for the embodiment of a contract; but this does not mean that any of them having to pass upon the validity of a claim once issued would hold it invalid, because it did not conform to the restrictions which they would have imposed if entrusted with the task of formulating it. The opinion of the Circuit Court of Appeals, and the statement accompanying it, shows that the examiner had approved various claims which were added to those in the original patent (and which he apparently considered as better definitions of the invention), also that the court examined all the references upon which he based his objection to the claims not approved and found that none of these references met the claims in controversy, under the construction placed upon them by the court. The presence of these new claims, reciting in terms qualifications which the court has found to be implied in the original claims, might have indicated to the examiner that these original claims were not intended to be thus limited in the reissue application, when if they had not been associated with these new claims, but stood as in the original, he would have allowed them, putting the same construction upon them as the court has. The significance of a claim may be greatly changed by the context. The discussion of these claims and of the references cited by the examiner, found in the opinion of the court, illustrates how superficial the preliminary action of the examiner was and how improper it would be to confound his action with a judgment or decree in a court of law. Defendants have had the benefit of whatever weight the opinion of the examiner concerning the effect of prior patents upon the claims in controversy was entitled to. The court in examining those prior patents and determining that they do not conflict with the claims in controversy (under the construction which it placed upon those claims) has had the benefit of these objections as fully as the Commissioner would have had if the question of allowing these claims had been carried before him in some other form than by a request for the return of the original patent.

Stress was laid by the Circuit Court upon there being no

appeal taken from the action of the examiner; but whether the course taken be or be not regarded as technically an "appeal," it was in every material sense an *appeal to the court* by the most direct method which the law afforded. The proceeding had not reached a stage in which an appeal could be taken in any other way, and if this was not a proper case for *reissue*, this was the only way the question of the validity of these claims could ever be submitted to any tribunal having jurisdiction. If there had been no other franchise in existence upon which the parties could present the issues to the court, their remedy might have been confined to a technical appeal or a bill in equity for the grant of the patent. The existence of the original patent gave them a more expeditious and convenient method of carrying the matter before the court. If they wished to secure any advantage from the application for reissue, any amendment or enlargement of their franchise, their remedy was by pressing their reissue application before the Patent Office, but if they wished to take the opinion of the court upon the validity and sufficiency of the *original patent*, the only proper course open to them, the only legitimate method of transferring the controversy from the examiner to the court, was that which they took. It meant a refusal to accept or be concluded by the opinion of the examiner, quite as plainly as any technical appeal could, and a submission of the rights conferred by the original grant to the court.

As the law then stood, the withdrawal of an application for reissue and the assertion of the original grant in a court having jurisdiction was, in a case of this kind, the simplest and most direct, if not the only method provided by statute for taking the opinion of the court upon the validity of the original claims.

The law has long recognized the impropriety of leaving applicants for patents to be concluded by a bureau which is not a legal tribunal, and in which knowledge of the law is not exacted as a condition of holding either the office of Commissioner or the position of examiner. Under the Act of 1836, as amended March 3, 1837, express authority was given to applicants for

patents who were dissatisfied with the action of the Office to bring a bill in equity before the Circuit Court to obtain a decree compelling the issue of such a patent as the Office refused to grant, and the same remedy was given in terms to applicants for reissue as well as to applicants for original patents. See Section 16 of Patent Act of 1836 (Walker on Patents, p. 542); Amendment of March 3, 1837, Section 8 (Walker on Patents, p. 550), and Amendment of March 3, 1839, Section 10 (Walker on Patents, p. 555). The Act of 1870 repealed prior acts, and while retaining the right to file a bill in equity to compel the issue of a patent where one had been refused by the Patent Office, did not in terms extend that remedy to applicants for reissue, but instead provided that the surrender of a patent for the purpose of reissue should only take effect "upon the issue of the amended patent," leaving the patentee still at liberty, if the Office refused to allow him such a reissue as he sought, to stand upon his original patent and take the opinion of the Circuit Court upon his rights thereunder. Care was taken to guard against placing him in any position where the Patent Office could destroy a patent over which the Circuit Court had jurisdiction while refusing to grant him one which he was willing to accept in its stead, and to preserve to him the right of recourse to the Circuit Court upon the original grant down to the time that grant had been superseded by his acceptance of a new grant.

The caution which has for many years been observed in framing the patent laws to protect the inventor against being concluded by any action of the Patent Office which was unsatisfactory to him, is in marked contrast to the theory of the defense that every expression of an examiner adverse to the applicant concludes him in respect to rights asserted under a grant which that examiner had no part in formulating, and in spite of the fact that the applicant, with the concurrence of the Patent Office, instead of accepting the views of the examiner, promptly removed the controversy to the courts having jurisdiction, by the most direct method afforded by statute.

The opinion of the Circuit Court of Appeals indicates that it was only out of deference to a *dictum* of this court in *Peck v.*

Collins, 103 U. S., 660, that it hesitated to overrule the defense founded on the reissue application, and that it saw no reason, either equitable or statutory, why the proceedings had upon the application for reissue should disturb the original grant or any rights which might otherwise have been asserted thereunder.

When it is observed that this *dictum* occurred in a case where the court was considering the effect of a *decree of court* in an *inter partes* controversy, *concluding both parties* as to the issue, and that this was the kind of "adjudication" to which this *semble* referred, it is apparent that the case gives no support to this defense or to the conclusion reached by the Circuit Court concerning it. The only suggestion which it contains is as to the effect of a *final judgment* of a court *having jurisdiction to determine the exact issue*, where that judgment is officially entered and not appealed from, and where the same judgment would have concluded the adverse party if it had gone against him.

In *Peck v. Collins* the patent had been surrendered under the law in force prior to 1870, by the provisions of which the surrender of the patent took effect upon the *filing* of the application for reissue (the statute having been changed in 1870, apparently for the express purpose of avoiding the harshness of this rule, so as to provide that a surrender should only take effect on the *grant* of the reissue), and while that application was pending an interference had arisen between the patentee and a party asserting that he, rather than the patentee, was the original inventor of the subject-matter in controversy. The litigation over this question had been carried to the Supreme Court of the District of Columbia and resulted in a *final decree* of that court adjudging that the opposing party, rather than the applicant for reissue, was the original inventor of that subject-matter, and ordering that the patent issue to him instead of to the applicant for reissue, and the patent had issued accordingly. The applicant for reissue was thus left without any patent, either original or reissued, and the fact that he was not the inventor of the subject-matter had been adjudicated by a court of competent jurisdiction,

whose decree had been duly entered. After the surrender of the patent the patentee entered into a contract to sell it to parties who were not informed of the surrender. The litigation arose over the deferred payments under that contract, which were resisted on the ground that the patent had been extinguished before the contract was made. The court sustained this defense, pointing out the difference between the effect of the old statute and the new. Recognizing the fact that under the new statute the patent did not become extinguished until the issue of the amended patent, it intimated (though it expressly disclaimed deciding) that, even under the present statute, if in the application for a reissue the (p. 665)

“title to the invention is disputed and adjudged against him it would seem that the effect of such decision would be as fatal to his original patent as to his right to a reissue.”

What the court here means by “*title to the invention is disputed and adjudged against him*” is plainly a *dispute* and *judgment* of the nature there under consideration—that is, a definite and final determination of the specific issue by decree of a court having jurisdiction of that issue, which, if it had gone the other way, would have equally concluded the opposing party. It did not intimate that anything less than a *judgment* officially entered as the final and conclusive disposition of the issue submitted to it, by a court having jurisdiction of that issue, could have any such effect, or that the distinction between a judgment and a mere expression of opinion was any less material in dealing with rights held under patents than in dealing with other rights. There is no resemblance between a case where the issue has been “adjudged” and a case, like the present, where the nearest approach to any official action was to return the patent unmodified, and thus relegate all questions concerning it to the courts having jurisdiction to enforce and adjudicate existing patents.

This court in a recent case, after citing *Peck v. Collins*, and referring to the distinction between the old law and the new, quoting the provision that the surrender “shall take effect up-

on the reissue of the amended patent," said (*Allen v. Culp*, 166 U. S., 505):

"These words were obviously inserted for the purpose of preventing the surrender taking immediate effect, and to postpone its legal operation until the patent should be reissued. When a patent is thus surrendered, there can be no doubt that it continues to be a valid patent until it is reissued, when it becomes inoperative; but if a reissue be refused, it is entirely clear that the surrender never takes effect, and the patent stands as if no application had ever been made for a reissue. . . . But if the original application for a reissue be rejected, the original patent stands precisely as though a reissue had never been applied for, unless at least the reissue be refused upon some ground equally affecting the original patent. If it were otherwise, every patentee who applies for a reissue would do so at the peril, not only of having his application refused, but of losing what he already possessed. This was the very contingency the act of 1870 was designed to provide against."

It would seem from the context that by the expression "unless at least the reissue be refused upon some ground equally affecting the original patent" the court meant either to avoid concluding the question suggested by the *dictum* in *Peck v. Collins*, when that question was not involved in the case before it, or merely to recognize the fact that any *ground of objection* to the reissue which was equally pertinent to the original would be available as a defense to the original, and its sufficiency as a defense would have to be determined by the court precisely as its sufficiency as a reason for refusing the reissue would have to be determined by the Patent Office. It would not be consistent with the context to read this language as implying that whatever an examiner objected to in the preliminary correspondence was thereby forfeited, for this would involve the very peril against which the court holds that the act of 1870 was designed to provide. It would deprive the patentee of control over the original, prior to the time when the surrender would take effect. It would compel him, when making an application for reissue, to incur the peril "of losing what he already possessed," if the examiner to whom the case was in the first instance referred cited references to the

original claims, no matter how foreign to the invention those references might be. It would exclude him from carrying the question of their validity directly before the court, even though he ascertained upon legal advice that there was no statutory ground for reissue, or found that the prosecution of the application for reissue was likely to involve more loss of time or more expense than he was willing to incur.

The Circuit Court of Appeals in the present case has expressly found that the references on which the examiner rejected the claims of the reissue application did not affect the validity of the claims of the original or present any reason why they should not be upheld and enforced.

In *Phelps v. Harris*, 101 U. S., 370, an action in ejectment was brought to oust the defendants who claimed under a partition made by Henry W. Vick. It appeared that the plaintiff had before brought against these defendants a bill in equity under a statute authorizing such bills to remove a cloud from the title to real estate. The defendants had answered to that bill in equity, pleading title under this partition. The matter had been litigated through the Supreme Court of the state, which had held that the Vick partition was good and rested its judgment in favor of the defendants on this finding. The plaintiff thereupon brought the suit in ejectment, and the judgment in the former case was pleaded in bar. The question whether this issue was *res adjudicata* was directly before this court. It determined it in the negative, pointing out the fact that, while the court in the former suit had based its decision upon the ground that the title under the Vick partition was good, the real question before that court was whether it was sufficiently clear that that title was bad to justify it in setting it aside, and that its opinion upon its validity, therefore, did not bar the action in ejectment or conclude the plaintiff against there litigating the same issue. This court said (p. 376):

“It is true that the court, in the former part of its opinion, discussed the question of the validity of the partition made by H. W. Vick and his son, and held that the partition was good, and that the title of Henry G. Vick to the lands in controversy was perfect, and, as a consequence, that the defendant's title was also perfect.

But this discussion was entered into for the purpose of showing that the title of the defendant was not so devoid of validity as to constitute a mere cloud on the title; and consequently that the case was not one in which a court of equity could give relief.

"We think, therefore, that the court below was right in determining that the decree in the equity case did not render the main controversy *res adjudicata*, but only decided that the bill would not lie; in other words, that it was not a proper case for a court of equity to determine the rights of the parties."

The difference between the question of approving claims for the purpose of embracing them in a new grant and the question of the validity of similar claims in an existing grant was much wider than the difference between the aspect in which the validity of the Vick title was presented in these two cases; and the decision in the chancery suit, which was held not to conclude the plaintiff, was carried to final judgment, duly entered in both the lower court and the court of final resort, while in this reissue application the Patent Office had taken no action concluding anybody upon any issue.

In *Russell v. Place*, 94 U. S., 606, this court held that a former judgment could only conclude parties "upon a question directly involved," and that

"if, upon the face of a record, anything is left to conjecture as to what was necessarily involved and decided, there is no estoppel in it when completed and nothing conclusive in it when offered as evidence."

In *Smith v. McCool*, 16 Wall., 560, this court held that a verdict without a judgment is of no validity, and quotes with approval the following passage from Greenleaf, underscoring the word "~~determination~~^{ed}" (p. 561):

"It is only where the point in issue has been *determined* that a judgment is a bar. If the suit has been discontinued, or the plaintiff becomes nonsuit, or for any other reason there has been no judgment of the court upon the matter in issue, the proceedings are not conclusive."

It then holds that where there had been a special verdict in an action in ejectment and the court below had rendered a judgment in favor of plaintiff on that special verdict, and

upon a writ of error this court had reversed that judgment and ordered judgment on the same special verdict to be rendered in favor of defendant, and it had been so rendered, this special verdict upon which judgment had been rendered did not conclude the plaintiff (who was the plaintiff in the former suit) in respect to the issue found by that verdict, in a subsequent action of ejectment upon a new title which would be affected in the same way by that issue, saying (p. 562):

“But neither the judgment of a concurrent nor exclusive jurisdiction is evidence of any matter which came collaterally in question, though within their jurisdiction, nor of any matter incidentally cognizable, nor of any matter to be inferred from argument.”

It laid stress on the fact that the party or his counsel might have regarded the issue in the former suit as not vital, since they were relying on propositions of law under which they claimed the judgment should be in their favor irrespective of the finding in this special verdict, and that they ought, therefore, not to be concluded by that finding in a subsequent suit, saying (p. 563):

“He may well have been, and doubtless was, less careful to introduce his full evidence, and to contest the facts found, including the one which the verdict was offered in this case to prove, than he would have been but for the confident assurance that they were all immaterial in respect to the judgment to be given, which he claimed must be in favor of his client.”

In *Reed v. Proprietors of Locks and Canals*, 8 How., 274, this court, in overruling the contention that the verdict of a jury in a former case upon the same issue concluded the parties, said (p. 291):

“There was no judgment of the court upon the verdict, which alone could give it the force or effect of *res adjudicata*.”

See, also:

Danielson v. Northwestern Fuel Co., 55 Fed. Rep., 49.

Etna Life Ins. Co. v. Board of County Com'rs, 79 Fed. Rep., 575.

Haldeman v. United States, 91 U. S., 584.

An order for a judgment is not equivalent to a judgment, and does not become operative until the entry of the judgment that the party recover the sum awarded.

Macnevin v. Macnevin, 63 Cal., 186.

Eastham v. Sallis, 60 Texas, 576.

See, also:

Gray v. Noon, 66 Cal., 186.

Estoppels or forfeitures are not favored in law or equity. They are not to be lightly assumed or to be inferred from any circumstance consistent with a different explanation. They must arise from some wrongful act of the person against whom they are invoked by which the person in behalf of whom they are invoked has been misled to his injury. There must be a wrong on the one hand, and a victim of that wrong on the other.

In *Ketchum v. Duncan*, 96 U. S., 659 (666), the Supreme Court says that estoppel *in pais* "operates only in favor of a person who has been misled to his injury." In *Railroad Company v. Dubois*, 12 Wallace, 47, the same court says (p. 64):

"No principle is better settled than that a party is not estopped by his silence unless it has misled another to his hurt."

In *Branson v. Wirth*, 17 Wallace, 52, the same court says (p. 42):

"If one person is induced to do an act prejudicial to himself in consequence of the acts or declarations of another, on which he had a right to rely, equity will enjoin the latter from asserting his legal rights against the tenor of such acts or declarations. But, then, the person charged has an opportunity of explaining, and equity will decree according to the justice of the entire case."

In *Henshaw v. Bissell*, 18 Wallace, 255, the same court says (p. 271):

"There is, therefore, no case for the application of the doctrine of equitable estoppel. For its application there must be some intended deception in the conduct or declarations of the party to be estopped, or such gross negligence on his part as to amount to constructive fraud.

"An estoppel *in pais* is sometimes said to be a moral question. Certain it is that to the enforcement of an estoppel of this character, such as will prevent a party

from asserting his legal rights to property, there must generally be some degree of turpitude in his conduct which has misled others to their injury. Conduct or declarations founded upon ignorance of one's rights have no such ingredient, and seldom work any such result. There are cases, it is true, where declarations may be made under such peculiar circumstances, that the party will be estopped from denying any knowledge of his rights; but these are exceptional, and do not affect the correctness of the general rule as stated."

In the present case there has been no dishonest or inequitable act on the one hand, and nobody misled on the other.

In making application for reissue, with no apparent purpose except to introduce additional claims, the executrix was undertaking to make a use of the reissue law understood to be sanctioned by the federal courts through reiterated decisions for a half century. If this widow was in error in following the custom then prevalent, of applying for a reissue for this purpose, it hardly becomes the federal courts to deal harshly with her because of that error. At the time the application was filed, any student of their decisions would have advised her that this was a legitimate use of the reissue law. There can be no pretext that her act was dishonest or fraudulent in purpose, or that it injured anybody. It was recalled before it had taken any effect. She and the minor heirs to whom the patent belonged derived no advantage from it; the public was not prejudiced by it; the defendants in this case were entirely unaffected by it; it never appeared in the public archives; there was no warrant for anybody to go to such correspondence for an interpretation of a grant that had issued years before, or to rely upon it as superseding that grant; the law had provided but one method by which the Patent Office could correct or modify it, namely, by a reissue, and the Office had never reissued it; there was nothing in its records that purported to be a correction of the original grant, or even indicated the opinion of anybody concerning the validity or scope of the original patent; if there had been, it would not have been an authoritative utterance by any tribunal whose decision was conclusive; it represented at most only the suggestions made by a subordinate whose opinion was only tentative and con-

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cluded nobody, upon questions disconnected with either the validity or the scope of the claims of the original patent, and which were not consummated by any act of the Patent Office or adopted by the applicant.

This court has had sufficient occasion to examine the correspondence contained in the files of patents which have ultimately passed to issue to appreciate how little objections or "rejections" by subordinate examiners signify as to the ultimate action of the Office, or of the examiners themselves, upon the allowance of claims. It must have observed that it is a common practice with many of them to refuse applications in the first instance without critically examining them, citing whatever will give a plausible excuse for postponing more serious attention, as a preliminary to having the applicant or his attorney explain the prior art to them, or for other trivial reasons; that they are not *judgments* concluding the matter in dispute, but mere instructive references to prior patents, raising the issue whether, in view of them, the applicant will modify his claims or insist upon them in their present form, inviting discussion of their bearing upon these claims, and affording an opportunity to consider whether it is expedient to distinguish more clearly from the prior patents in the terms of the claims; and that it is the rule rather than the exception for examiners to recede from their objections after hearing argument, and allow the claims either in terms or with modifications which do not restrict their scope but merely adopt the examiner's peculiar fancies about forms of expression. What the Circuit Court has treated as a "judgment" of the Patent Office is not even such a final expression of opinion by the subordinate as must necessarily precede the submission of the question to the examiners-in-chief, who, in turn, are subordinate to the Commissioner. It is nothing but a suggestion preliminary to argument or explanation, which would have to be followed by further consideration on the part of this subordinate examiner before the claims could be considered by his superiors.

This application signifies nothing as to the opinion of the executrix about the validity or scope of the original patent, if her

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This application signifies nothing as to the opinion of the executrix about the validity or scope of the original patent, if her

opinion upon a question of this kind were entitled to consideration. It was then customary to file applications for reissue whenever the original patent was considered defective in that it did not claim everything that the inventor was entitled to claim. The decisions out of which the reissue law grew had recognized this as a proper object of a reissue, and sustained patents in which the claims introduced by reissue were intended to cover portions of the machine that had not been covered in the original claims. This had been repeatedly recognized as a legitimate use of the reissue law under the present statute. In *Marsh v. Seymour*, 97 U. S., 348 (published shortly before this application was filed), the Supreme Court reiterated and applied its long recognized doctrine that a patentee was entitled in a reissue to (p. 356)

“include in the description and claims of the specification not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings, or patent-office model, which properly belonged to the invention as actually made and perfected. Corrections may be made in the description, specification, or claims of the patent where the patentee has claimed as new more than he had a right to claim, or where the description, specification, or claim is defective or insufficient; but he cannot, under such an application, make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent-office model.

“Extended discussion of these principles is unnecessary, as they are well settled by the repeated decisions of this court, and when properly applied to the case before the court, they show that the third assignment of error must be overruled, for the reason that the new patent does not contain anything beyond what was well described or suggested in the specification of the original patent.”

The reissues which that court sustained in this language were for inventions not covered by the claims of the original, and were taken out thirteen years after the original, being second reissues.

Not only did this action, under such circumstances, imply no opinion on the part of Mrs. Gorham, touching the sufficiency of the original patent to secure the inventions referred to in

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them, and all equivalents, but if it had, her opinion upon such questions could signify nothing, and certainly could not conclude anybody. She probably never read the patent, would not have understood it if she had, and was equally ignorant of mechanics and of legal rules of construction. There is no opinion expressed by the patentee himself, for he relied upon the original patent, and never made an application for reissue, or did anything tending to disparage his original patent.

The withdrawal of the application for reissue does not imply any doubt on the part of those who had succeeded to the title, or of their counsel, concerning their right to a patent containing every claim included in the application, and covering unmistakably all that was embraced in the original claims. It merely indicates that in their opinion there was no occasion for *reissuing* the patent. There was no reason why they should incur the expense and delay of prosecuting the application for reissue when the original patent would, in legal effect, by the usual doctrine of equivalents, cover the essentials of the machine. Their opinion that such was its effect was indicated by withdrawing the application and immediately filing suits upon the original. Entertaining such an opinion, it would have been folly for them to have squandered time and expense in prosecuting a reissue which could only take effect from the time of its grant, in the indefinite future. Moreover, the intervening decision in *Miller v. Brass Company*, coming after this application was filed, had cast doubt upon the *jurisdiction* of the Patent Office to entertain an application for reissue filed more than two years after the original patent was granted, where the original patent was valid and the only purpose of the reissue was to introduce additional claims. Under that decision the withdrawal of the application for reissue was the only consistent method of asserting the validity of its claims, for every argument in favor of the validity of those claims was an argument against the jurisdiction of the Patent Office. With these doubts about its jurisdiction, their withdrawal of the application while still in its incipient stage, before anything was concluded, and their assertion in court of the grant already in force, so far from being a renunciation

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of any rights held under the original patent, was an assertion of those rights and a prompt recourse to the only tribunal which had jurisdiction to construe and adjudicate a patent already in existence. It was in strict conformity to the intimations of this court that the right to apply for reissue was restricted to cases where there was actual mistake in the original rendering it inoperative. If satisfied that there was no such mistake in the original as this court held to be necessary to give the Patent Office jurisdiction over a reissue application, they could not make, or have the executrix or assignee make, the oath setting forth the mistake necessary to give jurisdiction for reissue under the new interpretation of the law. They could only withdraw the application for amendment and rely on the original grant. There is no reason why the applicant should be punished for having promptly relinquished the right of reissue, when this court, departing from former decisions, intimated that the Patent Office was not authorized to entertain such an application, and for having resorted to the course which the statute permitted in seeking a remedy under the existing patent through a tribunal whose jurisdiction was unquestioned.

Where there has been no semblance of fraud or bad faith of any kind on the part of the applicant, no benefit accruing to the applicant by the proceedings in the Office, and no acceptance of a substituted grant; where neither the defendants nor the public have been misled or prejudiced in any way during the pendency of the application; where doubt had meanwhile been cast by decisions of this court upon the jurisdiction of the Patent Office to grant a reissue in the absence of evidence of actual mistake in the original; where the Patent Office itself conceded the right of the applicant to withdraw the original patent in lieu of proceeding with the reissue application; and where it was immediately asserted as covering the subject-matter of the present controversy, before the only tribunal which had jurisdiction to pass upon the validity and scope of an existing patent; it would be a strange inversion of the presumptions against defeasance of existing rights, and of the rules governing equitable estoppel, to create out of these

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circumstances any forfeiture or impairment of the original grant. Certainly the presumption is that such a right continues in force until the grant is cancelled or decreed void by a court having jurisdiction to enter such a decree.

Suppose there had been a contract to which Gorham was a party, evidenced by a written instrument in force at the time of his death; that his executrix had proposed to the adverse party a modification of that contract and a draft of the proposed modifications had been submitted; that various objections had been made to the terms proposed in that draft and there had been more or less correspondence over it; that before any new instrument had been executed or agreed upon, and while the proposed modifications were still under discussion, she had, under advice of different counsel, elected to stand upon the original instrument, and had promptly withdrawn the proposal for amendment and brought suit on the existing contract; would any court seriously entertain the proposition that such correspondence could either defeat or impair the original instrument which both parties treated as in force until superseded by a modified contract? Would it be pretended that the proposed changes in the instrument, which had never been consummated, could deprive either party of any rights under the instrument that remained in force? Would a court treat with any respect the claim that the refusal of either party to incorporate certain additional provisions, or their insistence upon excluding certain provisions already in the instrument, concluded the opposing party against having the benefit of whatever provisions were in the original instrument as executed, or that they had not the same force and effect as if no efforts at revision had been made? Would such negotiations be competent evidence to modify or defeat the original contract? Was it in the power of the executrix to create an estoppel against a title which she held only in trust for the minor heirs, by any act from which they derived no benefit and others suffered no injury?

Any conduct which is fairly capable of a different interpretation cannot be construed into a waiver of a right, and the conduct here was not merely capable of an interpretation that implied no waiver; it was incapable of any interpretation other

circumstances any forfeiture or impairment of the original grant. Certainly the presumption is that such a right continues in force until the grant is cancelled or decreed void by a court having jurisdiction to enter such a decree.

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than the purpose to assert in the proper tribunal the title already granted.

The Circuit Court said that applicant should not be allowed to "experiment." It cannot properly be said that there was any "experiment" while the action of the Patent Office remained still undetermined. If while a cause is pending the plaintiff becomes satisfied that he has mistaken his remedy, or begun proceedings in the wrong court, does his withdrawal of suit with the express permission of that court, and prompt assertion of a different title in the court having jurisdiction to adjudicate that title, justify the latter court in holding that the "experiment" in seeking the wrong remedy or going into the wrong tribunal bars the plaintiff against relief under the title and in the court to which the controversy has thus been transferred? The Supreme Court has repeatedly held that the withdrawal of an application which had been refused by the examiner, and substitution of another covering in different terms the subject-matter of the first, was not an abandonment of or limitation on the substituted specification, but this would be rather mere "experimenting" on the Office than anything appearing here. See:

Godfrey v. Eames, 1 Wall., 317.

Smith v. Goodyear D. V. Co., 93 U. S., 486.

Bevin v. East Hampton, 9 Blatch., 50.

There is no principle of law which precludes a party who has asked for an amendment of a grant from withdrawing his application before any amendment has been agreed upon and standing upon the original grant which remains unmodified. There is no reason why, when a party has gone into one tribunal for relief, and while the cause is pending doubts have been cast upon its authority to grant relief, or other reasons have arisen why he prefers to seek relief in a different tribunal having unquestioned jurisdiction by relying upon a different title, the fact that he has at first mistaken his mode of relief or acted upon different advice from that which subsequently governs him should conclude him against asserting the different title in the proper court.

The assumption of the Circuit Court that there was any-

thing like an *acquiescence* in the adverse attitude of the examiner indicates a strange misconception of what took place. The executrix who filed this application, after the death of her husband, held the patent in trust for the minor children of the patentee. She had no power to release or forfeit any rights under the patent thus held in trust, except by exchanging the existing patent for a new grant, if she had in this way. Before anything concerning that application had been officially determined by the Patent Office, the title to the original patent was sold to parties who, when advised of the pending application for reissue, chose to retain the original. The Patent Office accorded them the right to take this course, and delivered to them the original franchise, unaltered, thus terminating the inchoate proceedings for reissue, which had never passed beyond the stage of confidential correspondence. Right under the original was thereupon promptly asserted by commencing suits under it. The return of this original patent containing the original claims, authenticated by the formal grant, sealed, signed and countersigned, as provided by statute, and resting upon the original grant, was the only disposition made of the application, and indicated that the Patent Office did not consider or intend anything which had occurred during the pendency of the application as affecting or qualifying any rights purporting to be granted in that patent.

The doctrine that the patent laws should, if possible, be so construed as to effectuate their purpose and secure to inventors to the full extent the exclusive enjoyment, for the term of the patent, of what they confer upon the public, has been too often expounded and applied by this court, through many of the most distinguished jurists who have sat upon this bench, to be lightly set aside. Neither the patentee nor his widow or children should be subjected to forfeiture of rights once acquired and duly authenticated, unless the statute unmistakably imposes such forfeiture, or some paramount equity compels it. If they sometimes take a course which greater wisdom or better knowledge of the law would teach them to avoid, they should not be punished so long as they withdraw before anything has been consummated or anybody been misled. Even though they ap-

proach a precipice, if they discover the peril in time to retreat, the court should not interfere to push them over it. If they are to be treated as *personæ non græte*, there is no reason why they should be deprived of all the protection which the statute affords them, why the terms of the statute should be wrenched in order to destroy a grant which the government has given for a consideration paid and accepted, why courts of equity should exercise their ingenuity in depriving the inventor, his widow and orphans, of the salutary rule which in other cases requires such courts to seek to effectuate rather than destroy, why they should create new and unheard of doctrines of estoppel for their destruction, why they should lie in ambush to ensnare them or dig pit-falls in their paths. The most ingenious inventors are usually strangers to the subtleties of language, the practices of the Patent Office, and the technicalities of the courts. They can describe a machine and point out the parts of it which they consider essential, designating them in terms that are intelligible to themselves and to the public; they can do everything that is necessary to put the public in possession of their invention; but they are usually much less adroit in guarding against imposition than they are original in contrivance. They find it hard enough to hold their own against those who are seeking to appropriate their inventions and deprive them of their rights; but if, in addition to this, they must run the gauntlet of hostile courts eager to discover some act or expression that can be wrested into a forfeiture not prescribed by statute, and facile in devising doctrines of estoppel which will serve the purpose of destroying their rights, there are not many inventors who can survive this test. A learned court reading a patent as a criminal lawyer would an indictment, searching for some flaw which will afford a pretence for defeating it, and free to contrive and apply such novel doctrines of estoppel or forfeiture as those proposed by defendants, would be more than a match for any inventor, and have no difficulty in overthrowing any patent or so curtailing its effect that infringers could appropriate its substance with impunity.

It is submitted that the intent and effect of the withdrawal of the application for reissue and the return of the original

patent was to leave the original grant unchanged and relegate to the court all questions affecting its validity and scope precisely as if no application for its amendment had been made, and that the question certified should be answered accordingly.

Respectfully,

ROBERT H. PARKINSON,
Counsel for Appellant.